

REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the pending claims is respectfully requested.

Claims 1-4 and 14-16 are pending and under consideration. Claims 5-13 have been cancelled without prejudice to or disclaimer of the subject matter recited therein.

Applicants acknowledge with appreciation the Examiner's indication that claims 15 and 16 include allowable subject matter.

REQUEST FOR WITHDRAWAL OF FINALITY

The Office Action indicates that the finality of the previous Office Action has been withdrawn, and indicates that the outstanding rejections are based on new rejection rationales. The Office Action further indicates that the outstanding Office Action can be made final because applicants previously amended the claims.

However, as applicants have not amended the claims between the previous rejection and the outstanding rejection, the outstanding Office Action should not have been final. If the previous Office Action was non-final, as indicated in the outstanding Office Action, then the outstanding rejection cannot be final if new rejection rationales are being presented.

In addition, as the Office Action indicates that applicant's previous remarks were persuasive, wherein applicant pointed out the lack of the then final Office Action responding to previous applicant remarks and failure to set forth sufficient prima facie obviousness cases, the outstanding rejection would be in response to applicant's persuasive arguments. Thus, requiring any further Office Actions issued in response to be non-final.

In addition, in view of the following comments, it is respectfully submitted that the outstanding rejections fail to meet prima facie anticipatory and/or obviousness standards, thereby requiring a new Office Action.

Accordingly, withdrawal of the finality of the outstanding Office Action and issuance of a new Office Action, if necessary, is respectfully requested.

REJECTION UNDER 35 USC 102 AND 103

Claim 14 stands rejected under 35 USC 102 as being anticipated by Duston et al., U.S.

Patent No. 3,538,298; claims 1 and 4 stand rejected under 35 USC 103 as being obvious over Duston et al., as applied to claim 14, and further in view of Scuricini, U.S. Patent No. 4,096,988; and claims 2-3 stand rejected under 35 USC 103 as being obvious over Duston et al., in view of Scuricini, and in further view of Misso et al., U.S. Patent No. 6,424,488. These rejections are respectfully traversed.

The rejected claims 1-4 and 14 set forth particular claim language requiring particular consideration, for example, a “disk.”

The claims should be interpreted in light of their plain meaning as understood by one of ordinary skill in the art. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), citing, In re Prater. Any applied “broadest reasonable interpretation” must also conform to the broadest reasonable interpretation afforded by one of ordinary skill in the art *when read in light of the specification*. In re Prater, 162 USPQ 541, 550-51, In re Morris, 44 USPQ2d at 1027, MPEP 2111.01 (7th Ed., rev. 1)(Feb. 2000).

Thus, claim terms must be considered in light of their context in the specification, as well as their context in each claim as a whole. The interpretation must also be “reasonable.”

The Office Action has structured the outstanding rejections on the premise that Duston et al. can be interpreted as disclosing the claimed disk.

In particular, the Office Action has indicated that Duston et al., which sets forth balancing high-speed rotating cylinder units, discloses the claimed: “disc assembly” driving a disc rotatably disposed at the driving source; measuring of an “eccentric portion of the” disc; and “a laser cutter moving to cut a portion of the disc corresponding to the measured eccentric portion, while the disc is not rotating.” The rejections of claims 1-4 rely at least on these interpretations of Duston et al., even though each claim sets forth additional and/or different particular patentably distinguishing features.

It is noted that the cylinder of Duston et al. is not a disk. Further, any eccentricity of the cylinder of Duston et al. is measured based on the fact that the rotating object is a cylinder. The measurement of eccentricity of a disk is different from the measuring of eccentricity of a cylinder.

In addition, Duston et al. further fails to disclose a disk assembly driving the disk rotatably disposed at a driving source. A driving source for rotating a disk is fundamentally different from a driving force for rotating a cylinder. Similarly, a disk assembly cannot be considered to be interchangeable with an assembly for rotating disks.

Likewise, Duston et al. similarly fails to disclose the claimed laser cutter moving to cut a portion of a disk corresponding to the measured eccentric portion. The cutting of an eccentric portion of a disk is different from cutting an eccentric portion of a cylinder.

The invention of Duston et al. is primarily drawn to adding an additional groove in a cylinder such that any laser etching of the cylinder will only etch a plateau portion circumferentially arranged around the cylinder and any overflow of etching material will fall off because of the etching area being a plateau. Regardless, the etching is performed in particular heavy areas around the cylinder according to the detected cylinder's eccentricity. Thus, any laser etching in Duston et al. is for compensating for cylindrical eccentricity, which is not the same as eccentricity of a disk.

The Office Action also indicates that Duston et al. also discloses performing the laser operations while the cylinder is not rotating. However, the Office Action is relying on the background of Duston et al. at col. 1, lines 49-62 to disclose the non-rotating feature and relying on the remainder of Duston et al. for the laser etching aspect. Yet, Duston et al. discloses that conventionally milling of cylindrical pieces using a strobe light to detect high portions of a cylinder and then "drilling" to remove excess portions of the cylinder when the cylinder is apparently not rotating. No laser is disclosed as being involved in this process.

However, Duston et al., beginning in col. 1, line 65, through col. 2, line 20, details that when laser etching the surface of cylinders the cylinders are etched while the cylinder is rotating. The remaining disclosure of Duston et al. sets forth similar rotating etching operations. For example, Duston et al. indicates that deposits of material are removed by "focusing a pulsed laser beam on the surface of a rotating object which lies between a pair of annular grooves." (See Duston et al. col. 3, lines 1-4).

Thus, Duston et al. fails to disclose the claimed laser cutting when the disk is not rotating.

As the remaining rejections apparently rely on these interpretations of Duston et al., it is respectfully submitted that corresponding interpretations for the rejections of claims 1-4 are equally inapplicable.

Lastly, it is respectfully submitted that the remaining references, Scuricini and Misso et al. similarly fail to support a prima facie obviousness standard, alone or in combination with Duston et al. Scuricini similarly is concerned with the eccentricity of cylindrical bodies, and it would not have been obvious to modify the disk of Misso et al. into Duston et al., or vice versa, for similar arguments as presented in the previous responses, incorporated herein, noting that similar

obviousness rejections have previously been withdrawn based on applicants arguments countering the same.

Therefore, for at least the above, it is respectfully requested that these rejections of claims 1-4 and 14 be withdrawn and claims 1-4 and 14 be allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

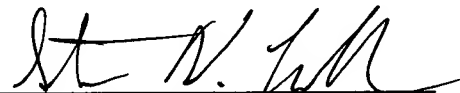
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

Stein, McEwen & Bui, LLP

Date: 1/21/2005

By: 
Steven W. Crabb
Registration No. 46,092

1400 Eye Street, NW, Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510